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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,539	03/10/2000	Sandee Gulati	VIALO-044650	4738

7590

04/05/2002

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EXAMINER

KIM, YOUNG J

ART UNIT PAPER NUMBER

1637

DATE MAILED: 04/05/2002

/0

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,539

Applicant(s)

GULATI ET AL.

Examiner

Young J. Kim

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 9-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

This Office Action responds the Amendment received on January 29, 2002 (Paper No. 9).

Election/Restrictions

Newly submitted claims 6, 7, and 9-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Originally prosecuted claims were drawn to method of determining viral load from a patient via use of viral diffusion curve determined from a microarray output. The claims recited above are drawn to an improved method of quantifying viral load from a patient, wherein the improvement comprises utilizing quantum resonance interferometry, a limitation patentably distinct from originally prosecuted claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6, 7, and 9-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Preliminary Remark

Claims 3-5 have been canceled.

Claim 8 is pending and under prosecution.

Priority

The objection to the specification for not containing a priority claim to its prior application in the first line of the specification, in the Office Action mailed on July 3, 2001, is withdrawn in view of the Amendment received on January 16, 2002, inserting the priority claim.

Claim Rejections - 35 USC § 112

The rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, in the Office Action mailed on July 3, 2001, is withdrawn in view of the Amendment received on January 16, 2002, canceling the claim.

Double Patenting

The statutory double patenting rejection of claims 3-5 under 35 U.S.C. 101, as claiming the same invention as that of claims 42 and 45 of prior U.S. Patent No. 6,245,511, in the Office Action mailed on July 3, 2001, is withdrawn in view of the Amendment received on January 16, 2002, canceling the claims.

Rejections – New Ground, Necessitated by Amendment

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is indefinite because the claim recites the phrase, "the output patterns of hybridization activity to respective coordinates," but fails to recite from what this output patterns are observed.

Double Patenting – Necessitated by Amendment

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 8 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 34 of prior U.S. Patent No. 6,245,511. This is a double patenting rejection.

Claim 8 is drawn to a computer system for determining the effect of one or more therapies upon a subject, comprising a memory that generates a viral diffusion curve, calibrates the viral diffusion curve, maps output patterns of an assay, and determines the viral load.

Claim 34 of U.S. Patent No. 6,245,511 is drawn to a system for determining the viral load within a biological sample, the system comprising, a viral diffusion curve generator, a calibration unit, a mapping unit, and a viral load determination unit.

Although the system of claim 8 of the instant application describes what the computer system does while the system of claim 34 of the '511 Patent is described by multiple units, the units are described as performing the same function as that of claim 8 of the instant application, thus duplicative in scope.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiries

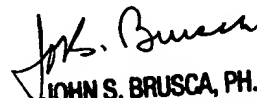
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (703) 308-9348. The Examiner can normally be reached from 8:30 a.m. to 7:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the

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Examiner's supervisor, Gary Benzion, can be reached at (703) 308-1119. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. The Fax number is (703) 746-3172. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Young J. Kim

3/27/02



JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER